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Dated: July 17, 2007

Signature: /Scott E. Baxendale/  
(Scott E. Baxendale)

Docket No.: 29621/GD0001A  
(PATENT)

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Paul Spitale et al.

Application No.: 10/807,940

Confirmation No.: 5130

Filed: March 24, 2004

Art Unit: 1744

For: METHOD FOR TUFTING BRISTLES AND  
BRUSH USING THE SAME

Examiner: Chin, Randall E.

### **RESPONSE TO RESTRICTION REQUIREMENT**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is being presented pursuant to 37 C.F.R. § 1.143 and in response to an Official action dated May 17, 2007, wherein pending claims 1-28 were subjected to a two-way restriction requirement. Specifically, the action defines the restriction based on the claimed invention as follows:

Group I: Claims 1-17, drawn to a hair brush, classified in class 15, subclass 191.1; and

Group II: Claims 18-28, drawn to a method of bristle and cushion pad fabrication, classified in class 300, subclass 21.

*See* the Action at p. 2. The action further asserts that the application contains claims directed to the following patentably distinct species of the claimed invention:

Species 1: Fig. 1; and

Species 2: Fig. 2.

*See* the Action at p. 3. The action does not identify which claims are directed to each of the allegedly patentably distinct species. The restriction requirement is traversed with respect to

the assertion that Figs. 1 and 2 depict patentably distinct species, and reconsideration and withdrawal of that portion of the restriction requirement are respectfully requested in view of the following remarks. Applicants do not traverse the restriction with respect to separating the apparatus claims from the method claims.

## I. The Restriction Requirement Is Traversed

### A. The Restriction

As bases for the restriction, the Office action alleges in conclusory fashion that the two species are distinct from one another, as follows:

This application contains claims directed to the following patentably distinct species: 1) Fig. 1 and 2) Fig. 2.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species.

\* \* \*

There is an examination and search burden of these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Action at p. 3. The Office action does not provide reasons and/or examples to support the conclusions that the identified species are patentably distinct or create an examination and search burden, but the Office action further states that “[c]urrently, no claims are generic.”

*Id.*

### B. The Office Action Does Not Provide Reasons and/or Examples to Support the Conclusion that the Identified Species are Patentably Distinct Species

For a restriction to be proper, the requirement for restriction must provide reasons and/or examples to support the conclusions. *See M.P.E.P. § 803 (8<sup>th</sup> Ed., rev. 3, Aug. 2005).* The restriction requirement is traversed because there is no demonstration that both

applicable criteria for distinctness among the species are present. The requirement only states that the identified species are distinct. Absent the required support for the conclusion that distinctness among the species and the claims exists, applicants respectfully request withdrawal of the requirement for restriction.

**C. Search and Examination of the Entire Application Can Be Made Without Serious Burden on the Examiner**

According to the M.P.E.P., for restriction to be proper, search and examination of the entire application must impose a serious burden on the examiner. *See M.P.E.P. § 803* (8<sup>th</sup> Ed., rev. 3, Aug. 2005) (“If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.”). The restriction requirement is traversed because there is no evidence that search and examination of the entire application would impose a serious burden on the PTO.

A serious burden on the examiner may be shown by an appropriate explanation of separate classification, separate status in the art, or a different field of search, among other reasons, but the Office action provides no explanation whatsoever of any burden on the examiner necessitating restriction of the claims. The identified species are concerned with similar subject matter. Figure 1 illustrates a brush 20 having a single bristle 28 per bristle anchor 26, and with a cushion pad 24 on the exterior of the brush and received in a receiving portion 36. Figure 2 illustrates multiple bristles 28 tufted in each bristle anchor 26, and the cushion pad 24 being disposed within the head of the brush 20. Without further explanation in the Office action, the applicants fail to see how the illustrated embodiments of the brush 20 create a search and examination burden on the Patent Office. Even assuming the pending claims of the application are directed to both embodiments, the examiner will search the same classes and subclasses of the hair brush arts for both single and multiple bristle tufts, and external and interior cushion pads. If different classes and subclasses would be searched, applicants respectfully request an identification of the relevant classes and subclasses for each species.

Because search and examination of the entire application can be made without serious burden on the PTO, it would be wasteful of the time, effort, and resources of both the applicants and the PTO to separate the currently-pending claims in an as yet unidentified manner and to prosecute the separated claims in separate applications. Furthermore, if the restriction requirement is maintained, the applicants will likely incur additional prosecution costs associated with filing one or more divisional applications, and the PTO will be required to perform duplicative searches. Thus, withdrawal of the restriction requirement for the species will actually *reduce* the burden on the PTO and on the applicants.

**D. Admissions Concerning the Patentability of the Claims Result if the PTO Maintains the Restriction Requirement**

If the restriction requirement is maintained, then the U.S. Patent and Trademark Office (“PTO”) admits that each identified species is patentable over the other species. *See, e.g.*, M.P.E.P. § 802.01 (8<sup>th</sup> Ed., rev. 3, Aug. 2005). These admissions are necessary to the PTO’s entry of the restriction requirement and may be relied upon by the applicants during examination of this application and future divisional applications, unless the restriction requirement is withdrawn. If the PTO is not making these admissions regarding patentability, then the restriction requirement should be withdrawn.

The restriction requirement also should be withdrawn because the restriction may present potential double patenting. According to the M.P.E.P., the patent statute (e.g., 35 U.S.C. § 121):

prohibits the use of a patent issuing on an application with respect to which a requirement for restriction has been made, or on an application filed as a result of such a requirement, as a reference against any divisional application, if the divisional application is filed before the issuance of the patent. The 35 U.S.C. 121 prohibition applies only where the Office has made a requirement for restriction. ... This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a *heavy burden* on the Office to guard against erroneous requirements for restrictions where the claims define essentially the same invention in different language and which,

if acquiesced in, might result in the issuance of several patents for the same invention.

*See M.P.E.P. § 804.01 (8<sup>th</sup> Ed., rev. 3, Aug. 2005) (emphasis added).* The applicants respectfully request reconsideration and withdrawal of the restriction requirement in view of the foregoing admonitions.

In view of the foregoing, the applicants respectfully request reconsideration and withdrawal of the restriction requirement for the species.

## **II. Provisional Election**

Pursuant to the requirements of 37 C.F.R. § 1.143, the applicants hereby elect the claims of Group I, Species 1, namely claims 1-17, for continued examination. . Should the Examiner disagree that each of the pending claims reads on the subject matter identified in the Office action as Species 1, applicants respectfully request that the Examiner either contact the undersigned directly or provide an explanation of the reasons why any of the pending claims do not read on the subject matter of Species 2.

## **III. Conclusion**

Should the examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, he is urged to contact the undersigned attorney.

Dated: July 17, 2007

Respectfully submitted,

By /Scott E. Baxendale/

Scott E. Baxendale

Registration No.: 41,605

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicants